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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,804	01/05/2001	Plinio Meyer	FE-12 PCT	8417

7590

04/09/2003

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EXAMINER

HESS, DANIEL A

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,804

Applicant(s)

MEYER, PLINIO

Examiner

Daniel A Hess

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of an amendment on 3/26/2003, which has been placed in the file of record, and to which this action is a reply.

Remarks

2. The rejections included below are essentially those of the first action. The reasons for this are given in the *Response to Arguments* section below. **This action is made FINAL.**

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

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In the present instance, claims 15 and 23 recite (i.e. in the context of 'and/or') the broad recitation 'or', and the claims also recite 'and' which is the narrower statement of the range/limitation. In this case, for the sake of examination on the merits, the broader statement is used.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 15-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Brasington et al. (EP 0 893 787 A2).

Brasington teaches all of the elements and means as recited in claims 1-14 drawn to a method of vending customized franking markings such as postage stamps. For example Brasington teaches the following:

Re claims 15, 28 and 29: A vending machine prints personalized stamps (column 3, lines 19-21). Note that postage stamps are a type of franking markings. The vending machine shown in figure 1 is clearly a computer; it has input, output and also processing capability. This processing capability is evidenced by its 'digitally creating' an image (column 3, lines 40).

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Pictures are taken and displayed (column 4, line 58 to column 5, line 1). Labels are then printed (column 5, lines 5-11); this constitutes 'support material.'

Re claims 16, 17 and 26: The user can select from (column 4, line 58 to column 5, line 5) various pictures on a screen, making a choice on a keyboard.

Re claim 18: There is a 'vending machine' (column 2, lines 10-20); this implies self-service.

Re claim 19: The user determines the value of the postage stamps (column 7, lines 36-42).

Re claim 20: A digital camera (column 3, lines 35-37) is used.

Re claim 21: Printing is triggered by a key selection, namely the selection of a particular image (column 5, lines 1-10).

Re claims 22 and 23: As Brasington notes (column 4, lines 40-45), a credit check is performed in order for the transaction to proceed. This amounts to checking for 'sufficient credit.'

Re claims 24 and 25: Note that (see Figure 1) the aperture 9 (column 3, lines 35-37) is built into the computer and must connect to it because the image is digital and is displayed on the screen.

Re claim 27: In addition to credit, there is also capability for 'paper money and coin accounting' (column 3, lines 48-49).

Re claim 30: Brasington envisions (column 6, lines 34-36) postage metering.

Response to Arguments

7. Applicant's arguments filed 3/26/2003 have been fully considered but they are not persuasive. In the first paragraph of page eight of the applicant's response, the applicant argues that his stamp can have "an image taken from alternative and unlimited proposals." The applicant argues in essence that his invention has a broader range of functionality. But the claim language does not reflect this. Because the applicant uses the word 'or' extensively in each independent claim, he ends up leaving much of the independent claim limitations as optional elements. For example, by choosing certain options at the 'or' juncture of claim 15, claim 15 can end up having the same meaning as "A method of producing franking markings by printing in a provided support material with an image, the method comprising generating by input means of a computer an image and transferring the image to a supporting material for printing one or more franking markings."

8. The applicant states on page 8 that a wide variety of applications are discussion on pages 3 and 4 of the instant application beyond the Brasington reference's teachings, but the claims are broad and do not detail these various applications.

9. Additionally, claims 15 and 23 have the same 35 USC 112 problem relating to ambiguity of 'and/or' that was objected to regarding certain claims in the previous action. These claims are further rejected under 35 USC 112.

10. Also, re claim 20, the use of a camera is plain throughout Brasington, and 'reading an image' is very broad language that can be construed as simply taking a picture.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
12. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.
14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.
15. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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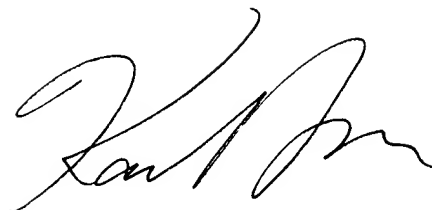
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A handwritten signature in black ink, appearing to be 'DAH' with a long, sweeping flourish extending upwards and to the right.

DAH

April 5, 2003

Daniel A Hess
Examiner
Art Unit 2876

A handwritten signature in black ink, appearing to be 'Karl D. Frech' with a large, stylized 'K' and 'F'.

KARL D. FRECH
PRIMARY EXAMINER